

Application No. 09/474,043
Attorney Docket No. 141509.00000

REMARKS

Reconsideration of the present application is respectfully requested in light of the above amendments to the application and the following remarks.

Regarding the Claims

Claims 57, 58, and 61-64 have been amended. Currently pending in the application, therefore, are Claims 33-64, of which Claims 33, 57, 58, and 61-64 are independent. No new matter has been added.

Claims 57-64 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended Claims 57, 58, 61-64 to reflect the fact that the elastomer material is essentially free of polystyrene homopolymer.

Claims 33-45, 52-57 and 61-64 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Berry in view of newly cited references Palomo et al and Wang.

Berry uses facings that are apertured, crimped or creped (col. 9, lines 14, 46). Berry stretches the film only to 100% (see Example 1) and then laminates to the apertured facings. The extensibility mainly comes from the apertured facings. Berry's film would likely break if stretched prior to bonding to the degree the film of the present invention is stretched. Berry discusses extensibility (col. 2, lines 42-47), but does not discuss elongation with recovery.

Palomo et al. does not discuss elongation at break and appears to be focused on an area other than elasticity.

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Wang discloses a material that is not a laminate. Furthermore, Wang does not discuss breathability.

PRIMA FACIE CASE OF OBVIOUSNESS

To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Roy*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.P.A. 1974).

NO MOTIVATION TO COMBINE REFERENCES

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination"). Whether motivation to combine the references was shown we hold a question of fact. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[P]articular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes" (emphasis added); Monarch Knitting, 139 F.3d at 881-83, 886, 45 USPQ2d at 1982, 1985 (treating motivation to combine issue as part of the scope and content of the prior art and holding that genuine issues of fact existed as to whether one of ordinary skill in the art would have been motivated to combine the references in question).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Although a reference need not expressly teach that the disclosure contained therein should

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be combined with another, see Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 2221 U.S.P.Q. 929, 933 (C.A.F.C. 1984).

The material of the present invention is not obvious over Berry in view of Palomo et al. and Wang. There is no teaching, suggestion nor reason to use the material of Wang in the laminate of Berry to achieve the material of the present invention. As previously stated, Berry is focused on a bandage having a film ("It follows from the nature of the product that the fabric layers of elastic bandages of the invention will be extensible in the length direction of the bandage"; col. 2, lines 43-45), not focused on high elasticity of the level set forth in the claims as amended and thus discusses stretching the film only 100% prior to lamination. Palomo et al. is focused on hospital gowns, which typically do not have significant elasticity demands. Wang is directed to high elasticity foams and not to a laminate material. Wang does not discuss breathability. Wang does not discuss any use analogous to the articles formed from the material of the present invention. Wang discusses intended uses as a gasket or sealing strip (col. 7, lines 60-64) which would likely need to minimize breathability to improve the sealing qualities, thereby teaching away from the present invention.

There is no suggestion nor motivation in the cited references to create a material of the

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present invention having exemplary breathability as well as elongation at break properties, in part because the materials the references cite are not designed for the use and environment for which the present invention is contemplated. There is no suggestion that the processes of the three references be combined to produce a material of the present invention. Therefore, Applicant respectfully submits that the Claims as amended are not rendered obvious by the cited references.

Claims 33-45, 53 and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang.

Wang does not discuss breathability of the foam material made. It cannot reasonably be inferred that Wang's material has inherent breathability. In contrast, the material of the present invention does have desirable breathability characteristics suitable for the articles into which the laminate material may be formed (see Table 1 of the present application with respect to WVTR exemplary data). Thus, Wang does not anticipate the present invention as claimed.

Claims 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Palomo et al. and Wang as applied to Claims 33-45, 52-57 and 61-64 and further in view of Shah.

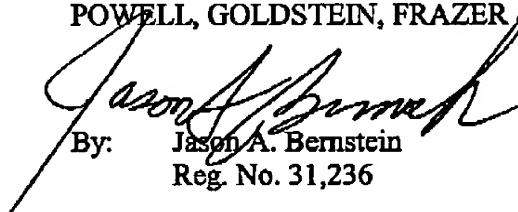
Shah is cited as disclosing polyurethanes to make elastomeric material films as well as styrenic triblock polymers. Shah does not disclose a material that is essentially free of polystyrene homopolymer and thus would not likely have the breathability or elasticity qualities as presented in the amended claims of the present invention. As such, as discussed above, there is no suggestion, teaching or motivation to combine Shah with the remaining references to derive the present invention as claimed. Thus, Applicant respectfully submits that the present invention is nonobvious over the cited combination of references.

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Claims 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Palomo et al. and Wang as applied to Claims 33-45, 52-57 and 61-64 and further in view of Cheung. The foam layer of Cheung and process of forming such material does not disclose, teach or suggest the laminate material with the accompanying material properties language of Claims 46-47 (as dependent from the amended claims) when taken in combination with the other cited references as discussed above. Thus, Applicant respectfully submits that the present invention is nonobvious over the cited combination of references.

Therefore, Applicant submits that the amended claims overcome the Examiner's rejections and objections and are in condition for allowance, and Applicant respectfully requests the same. Should the Examiner have questions or suggestions which will put this application in line for allowance, he is requested to contact the undersigned attorney.

Respectfully submitted,
POWELL, GOLDSTEIN, FRAZER & MURPHY LLP


By: Jason A. Bernstein
Reg. No. 31,236

16th Floor
191 Peachtree Street, NE
Atlanta, Georgia 30303-1736
(404) 572-6900